

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte THOMAS R. BEAL, DENNIS W. CHALMERS,  
and ERIC C.W. LIN

---

Appeal No. 1998-2514  
Application No. 08/426,917

---

ON BRIEF

---

Before FLEMING, LALL, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection<sup>1</sup> of claims 1, 5-8, 21-25, and 42-44, which are all the claims remaining in the application.

We reverse.

---

<sup>1</sup>Although a final rejection has not been entered against the claims, we have jurisdiction under 35 U.S.C. § 134(a) because the claims have been “twice rejected.” See also 37 C.F.R § 1.191.

### BACKGROUND

The disclosed invention is directed to a automated cassette library apparatus for transferring video cassettes from positions on shelves to video cassette players, and returning the cassettes to the shelves. Claim 1 is reproduced below.

1. An automated cassette library apparatus comprising:
  - a housing;
  - a plurality of cassette shelves, each cassette shelf of said plurality of cassette shelves being disposed horizontally within said housing;
  - a plurality of cassette players, each cassette player of said plurality of cassette players being disposed horizontally within said housing; and
  - a cassette transport unit disposed horizontally within said housing, said cassette transport unit having a cassette carrying cavity therein and including a plate having a longitudinal axis which extends in the direction of a first axis, said plate having a cassette supporting segment and being movably mounted to said cassette transport unit, first means disposed in said cassette carrying cavity for selectively transferring said cassette supporting segment in the direction of said first axis from a position below a cassette shelf of said plurality of cassette shelves to a position within said cassette carrying cavity in a first mode and from a position within said cassette carrying cavity to a position below a cassette shelf of said plurality of cassette shelves in a second mode; second means disposed in said cassette carrying cavity for selectively transferring a cassette in the direction of a second axis which is perpendicular to said first axis from said cassette carrying cavity into a cassette player in a third mode and from a cassette player into said cassette carrying cavity in a fourth mode; and third means disposed in said housing (a) for selectively transporting said cassette transport unit in the direction of a third axis, which is perpendicular to said first axis and said second axis, and relative to said plurality of cassette shelves and said plurality of cassette players when said cassette supporting segment is disposed within said cassette carrying cavity; (b) for selectively transporting said cassette transport unit in the direction of said third axis, at the beginning of said first mode when said cassette supporting segment is disposed below said cassette shelf, to move said cassette supporting segment

towards and into engagement with a cassette to selectively transfer a cassette from a cassette shelf to said cassette carrying cavity, and (c) for selectively transporting said cassette transport unit in the direction of said third axis, at the end of said second mode when said cassette supporting segment is disposed below said cassette shelf, to move said plate away from and out of engagement with said cassette to selectively transfer a cassette from said cassette carrying cavity to a cassette shelf.

The examiner relies on the following references:

Blumberg	4,734,005	Mar. 29, 1988
Motoyoshi et al. (Motoyoshi)	4,827,463	May 2, 1989
Suzuki et al. (Suzuki)	4,910,619	Mar. 20, 1990
Searle	5,235,474	Aug. 10, 1993
Tsuyumine et al. (Tsuyumine) (published Japanese patent application) <sup>2</sup>	3-063959	Mar. 19, 1991

Claims 1, 5, and 42-44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Suzuki, Motoyoshi, and Blumberg.

Claims 6-8, 21, and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Suzuki, Motoyoshi, Blumberg, and Searle.

Claims 23-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Suzuki, Motoyoshi, Blumberg, and Tsuyumine.

We refer to the Rejection (Paper No. 6) and the Examiner's Answer (Paper No. 9) for a statement of the examiner's position and to the Brief (Paper No. 8 ) and the Reply

---

<sup>2</sup> The rejection refers to the reference by a translation of the assignee's name, "Matsushita Electric Ind Co Ltd." An English translation of the document has been provided by the USPTO, and has been placed in the instant file wrapper.

Appeal No. 1998-2514  
Application No. 08/426,917

Brief (Paper No. 10) for appellants' position with respect to the claims which stand rejected.

### OPINION

At the outset, we note that a rejection for obviousness-type double patenting was entered against claims 1, 5-8, 21-25, and 42-44. (See Rejection at 2.) However, the rejection was not repeated in the Answer. Appellants filed a paper on April 28, 1997 which purports to be a terminal disclaimer. However, there is no indication in the file that the paper has been reviewed for compliance with the requisite formalities, nor that appellants have been notified that the paper is acceptable. Nor is there any indication on the face of the file wrapper that the application is subject to a terminal disclaimer. The record should be clarified before the application is passed to issue. In any event, we assume that the rejection for obviousness-type double patenting has been withdrawn, and we will not address the rejection further.

As evidence of obviousness of the subject matter of claims 1, 5, and 42-44, the examiner offers the teachings of Suzuki, Motoyoshi, and Blumberg. As the rejection sets out on pages 4 through 9 of the Answer, Suzuki is deemed to disclose essential features of the invention as claimed, but does not show "a gripper mechanism or related hardware," or that the "third means causes the lifting and dropping off of the cassettes in the first and

second modes of operation, respectively." (Answer at 5.) The rejection turns to Motoyoshi and Blumberg for suggestion of the features missing from Suzuki.

Appellants argue, inter alia, that the "plate" set forth in claim 1 is not disclosed or suggested by the references (Brief at 13-17). On page 15 of the Brief, appellants note that the rejection refers to "plate 29 of Motoyoshi," and submit arguments against a combination which may include the "plate" disclosed by Motoyoshi.

The examiner responds (Answer at 12-13) that Motoyoshi was relied upon for teaching a "gripper mechanism"; Blumberg was relied upon for a "plate" which exchanges cassettes using a "forklift motion." We observe that the rejection refers (id. at 5) to Motoyoshi "having a plate (29)." The rejection refers (id. at 6) to Blumberg disclosing a "plate" having a "longitudinal axis." However, the Answer at page 8 refers to "the plate of the vertical transporting means of the device of Suzuki et al as modified in view of Motoyoshi et al...." At the bottom of page 8 of the Answer, the rejection further alleges obviousness of "[s]izing and shaping the plate of Suzuki et al as modified in view of Motoyoshi...." Since the examiner has not pointed out a "plate" in Suzuki, we assume, as did appellants, that "plate" 29 of Motoyoshi is submitted as being suggestive of the "plate" that is claimed.

Motoyoshi discloses, in the embodiment described at column 6, line 21 through column 11, line 21, a "moving (or "movable") body 29" (Fig. 9) to which is attached, inter alia, clampers 40 and leaf springs 52 which serve to support cartridge 1 as it is removed

from shelves in stocker 2 (Fig. 1). A sensor 64 on body 29 detects a rear face of cartridge 1. As shown in Figure 6, leaf springs 53 and 52 support cartridge 1 as it is drawn into, or pushed from, inserting and retrieving mechanism 4.

Instant claim 1 requires, inter alia, that the cassette transport unit include "a plate having a longitudinal axis which extends in the direction of a first axis, said plate having a cassette supporting segment and being movably mounted to said cassette transport unit," and further a "first means" and a "third means" with functions related to movement of the "cassette supporting segment."

The rejection is unclear with regard to what element or elements in claim 1 is interpreted as a "gripper mechanism," for which the Answer (at 5-6) turns to Motoyoshi. However, a structure corresponding to the "plate" required by claim 1 has not been shown in either of Suzuki or Motoyoshi. Nor has any suggestion been shown from the combined teachings of the references which renders obvious the above-noted language. As the examiner acknowledges (id. at 4), Suzuki discloses belts and rollers (Fig. 2B) for conveying the cassette 1.

Although seemingly inconsistent with earlier findings, the Answer at page 15 states that a "plate like the one shown in Blumberg (179) would be incorporated into the device of Suzuki et al as part of the modification." Blumberg discloses (Figs. 11-13; col. 13, li. 64 through col. 15, li. 41) a cassette lifting arm 179 which more nearly meets the structural requirements of the claim 1 plate than does "plate" 29 of Motoyoshi. However, the

rejection relies on Blumberg for the "forklift" action (vertical movement) shown in Figure 11. The examiner has not identified, and we do not find, any suggestion for combining the "plate" of Blumberg with the cassette transport system disclosed by Suzuki.

Moreover, appellants' arguments (e.g., Reply Brief at 4-5) with respect to the lack of showing of a motivation to combine the references are well taken. The Answer at page 7 alleges that the artisan would have been motivated to replace the "belts and rollers" with a "gripper assembly" for "more positive contact." The rationale appears to be based on speculation; no objective teachings from the prior art have been supplied.

For the foregoing reasons we cannot sustain the rejection of claim 1. Each of independent claims 42 and 44 contains the limitation of a plate having a cassette supporting segment in combination with at least a "first means" and "third means" relating to movements of the plate, in language following that of claim 1. We therefore do not sustain the rejection of claims 42 and 44, nor the rejection of claims 43 and 5, depending from claim 42.

The references of Searle and Tsuyumine have been applied against the remainder of the claims, 6-8 and 21-25, which depend from independent claim 1. The additional references, however, fail to remedy the deficiencies in the rejection against the subject matter of claim 1. We therefore do not sustain the rejection of any of claims 1, 5-8, 21-25, and 42-44.

Appeal No. 1998-2514  
Application No. 08/426,917

CONCLUSION

The rejection of claims 1, 5-8, 21-25, and 42-44 is reversed.

REVERSED

MICHAEL R. FLEMING  
Administrative Patent Judge

PARSHOTAM S. LALL  
Administrative Patent Judge

HOWARD B. BLANKENSHIP  
Administrative Patent Judge

)  
)  
)  
)  
)  
) BOARD OF PATENT  
) APPEALS  
) AND  
) INTERFERENCES  
)  
)  
)  
)  
)



Appeal No. 1998-2514  
Application No. 08/426,917

YOUNG & THOMPSON  
745 SOUTH 23RD STREET 2ND FLOOR  
ARLINGTON , VA 22202